



Genentech Patent Docket P2533C2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of David Botstein et al. Serial No.: 09/723,703 Filed: 28 November 2000 For: CARDIOTROPHIN-1 COMPOSITIONS AND METHODS FOR THE TREATMENT OF TUMOR	Group Art Unit: 1642 Examiner: L. Helms	RECEIVED JUN 26 2002 TECH CENTER 1600/2 HJ KJ 6-28-02
CERTIFICATE UNDER 37 CFR 1.10 <u>EL 809 450 264 US: Express Mail</u> I hereby certify that this correspondence and related documents are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated below and are addressed to the Commissioner of Patent and Trademarks, Washington, D.C. 20231 June 18, 2002 Yvonne Carter		

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

This document is submitted in response to the Office Communication mailed May 22, 2002 for which a one month response was given making this response is due on or before June 24, 2002 because June 22, 2002 falls on a Saturday. In view of the discussion provided, reconsideration of the requirements is respectfully requested.

Restriction Requirement

Pending claims 1, 3, and 24-35 were restricted into the following groups under 35 U.S.C. § 121:

- I. Claims 1, 3, 24-27, and 33, drawn to a method of diagnosing tumor in a mammal by detection of the expression of CT-1 with a probe of SEQ ID NO:1 or SEQ ID NO:2 and comparing the level of expression to control cells, classified in class 435, subclass 6.
- II. Claims 28-32 and 34-35, drawn to a method of diagnosing tumor with a probe of SEQ ID NO:1 or SEQ ID NO:2 and detecting the number of copies of a nucleic acid and comparing the copy number to a marker gene, classified in class 435, subclass 6.

Applicants respectfully traverse the Restriction Requirement because the claims in Groups I and II are of the same class and subclass causing no undue burden on the Examiner in a search of the relevant literature. Withdrawal of the Restriction Requirement is respectfully requested.

In the event that the restriction requirement is not withdrawn and merely to advance prosecution and allowance of claimed subject matter, Applicants elect Group II, claims 28-32 and 34-35 drawn to the subject matter as described above.

Species Election Requirement

Applicants are required to elect a species of tissue from a list of various cancers because allegedly the species are patentably distinct due to each having its own epidemiology and art.

Applicants respectfully traverse the election of species requirement because a search of the literature encompassing the invention as applied to one form of cancer is readily and easily applicable to a search of the literature encompassing the invention as applied to another form of cancer and would not place an undue burden on the Examiner. Further, the epidemiology of cancer is not the subject matter of the invention, making the election improper. Withdrawal of the requirement for election of species is respectfully requested.

Without acquiescing to the election requirement, Applicants elect Species C, colon cancer.

Applicants reserve their right to obtain claims encompassing a reasonable number of species prior to allowance of the claims, according to 37 CFR § 1.146., such that the scope of the allowed claims encompasses the breadth of Applicant's invention.

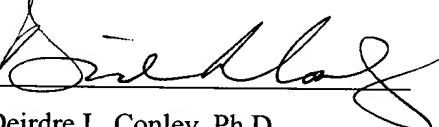
If the Examiner has any questions, the Examiner should feel free to call the undersigned attorney at the number indicated below.

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This document is timely filed with a transmittal letter within the one-month period for response. Applicant believes that no fees are due with this submission. In the unlikely event that this document is separated from its transmittal letter and/or fees are due, Applicant hereby petitions the Commissioner to authorize any extensions of time and/or to deduct fees from or add credits due to our Deposit Account 07-0630 as necessary to maintain the pendency of this application.

Respectfully submitted,
GENENTECH, INC.

Date: June 18, 2002

By: 
Deirdre L. Conley, Ph.D.
Reg. No. 36,487
Telephone No. (650) 225-2066



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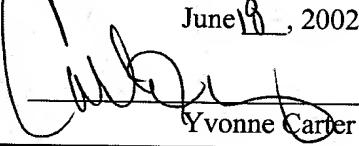


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Genentech Patent Docket P2533C2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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TRANSMITTAL LETTER

Assistant Commissioner of Patents
Washington, D.C. 20231

RECEIVED

JUN 26 2002

Sir:

Transmitted herewith are the following documents:

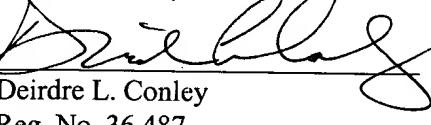
TECH CENTER 1000/200

1. Response to Restriction and Election Requirement - 3 pages
2. Postcard

Applicants believe that no fees are due with this submission. In the event, however, that any fees are due in connection with the filing of these documents, the Commissioner is authorized to charge such fees to our Deposit Account No. 07-0630.

Respectfully submitted,

GENENTECH, INC.

By: 
Deirdre L. Conley
Reg. No. 36,487
Telephone No. (650) 225-2066

Date: June 18, 2002



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